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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,723	02/06/2002	Andreas Verwold	F-7305	1967

28107 7590 09/26/2003

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EXAMINER

PHAN, THIEM D

ART UNIT PAPER NUMBER

3729

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/072,723

Applicant(s)

VERWOLD, ANDREAS

CS

Examiner

Tim Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group II (Claims 10-11) in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the examiner has not established a prima facie case of serious burden of examination of the inventions of Groups I and II together. This is not found persuasive because the examiner has established a prima facie case having shown in Paper No. 7, that the invention of Group I has a separate classification (Class 29, subclass 281.1) from the invention of Group II (Class 174, subclass 611). Moreover, the inventions of Groups I and II each have a separate status in the art and clearly have a separate field of search.

In accordance with MPEP § 803, the examiner has demonstrated that the inventions of Groups I and II are each independent or distinct as claimed (indicated in Paper No. 7) and a serious burden would be placed on the examiner as discussed above. The requirement is still deemed proper and is therefore **made FINAL**.

Claims 1-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group I, there being no allowable generic or linking claim.

Applicant is required to cancel these nonelected Claims (1-9) or take other appropriate action.

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An Office Action on the merits of Claims 10 and 11 now follows.

***Title***

2. The following title is suggested: "A Method Of Manufacturing A Folding Top For A Convertible".

***Specification***

3. The disclosure is objected to because of the following informalities:
- the attempt to incorporate subject matter into this application by reference to the Claims (Cf. Specification, page 2, lines 5-7) is improper because a cancellation or renumbering of the Claims will render the disclosure awkward and confused;
  - "levers 16 1," should be "levers 16," .

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, because the claims are written in such a fashion that they are not active verbs and therefore the metes and bounds of the claimed invention is difficult, if not impossible, to determine. For example, in claim 10 "... being enclosed ..." (line 2), "... connected with both by..." (line 3), "... are connected with ..." (lines 5 and 6), ...; in claim 11 "... connected with ..." (lines 2 and 4), "... are released ..." (line 4), etc ... are not in a form which clearly delineates the scope of the claims in U.S. Patent practice.

These claims 10 and 11 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Several phrase in the claims are vague, indefinite, awkwardly and/or confusingly worded, for example: "a windowpane, with a windowpane, the windowpane ..." (claim 10, line 2) it is repetitive and confused; "the part" (claim 10, line 3), "the frame region" (claim 10, lines 3, 5 & 7), "the folding top part" (claim 10, line 4) and "the part of the folding top" (claim 10, line 6) lack proper antecedent basis, ...

Applicant is hereby noticed that the claims will not survive another rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. Applicant would do well if he(she) carefully reviews and rewrites

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each of the claims 10 and 11 with the view of using positive, active and clearly worded language in order to properly claim any patentable subject matter.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stolz et al (US 5,040,844) hereinafter '844.

**As applied to claim 10**, the '844 teaches a method of mounting a window pane in a flexible roof encircling the frame region which meets all of applicants' claimed limitations, including:

- a step of connecting the window pane (Cf. Fig. 2, element 1) being enclosed between the folding region (Cf. Fig. 2, element 11) of the folding top or roof cover (Cf. Fig. 2, element 2) and the covering strip or support band (Cf. Fig. 2, element 7) by applying the heating electrodes (Cf. Fig. 2, element 10) to the adhesive strip (Cf. Fig. 2, element 5);

- a step of connecting the covering strip or support band (Cf. Fig. 2, element 6) with part of the folding top or roof cover (Cf. Fig. 2, element 2) by adhesion (Cf. column 3, line 26), except for electrodes heating the adhesive between the covering strip or support band (Cf. Fig. 2, element 6) and the folding top or roof cover (Cf. Fig. 2, element 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply outside or built-in electrodes heating to the adhesive between the covering strip or support band and the folding top or roof cover, since it was known in the art that electrodes heating is applied on the first step to hot-melt the adhesive (Cf. column 3, lines 50-61).

**As applied to claim 11**, the '844 teaches the claimed invention except for releasing the means that was edging the window pane and separating the covering strip from the folding top, to permit the sealing between the covering strip from the folding top.

It would have been an obvious matter of design choice to apply such releasing means since it was known in the art that the window pane, the adhesive layers and the folding region are accurately edged together (Cf. Fig. 2) for electrodes heating at one step and the covering strip or support band (Cf. Fig. 2, element 6) and the folding top part or roof cover (Cf. Fig. 2, element 2) are pressed together for sealing.

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*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 703-605-0707. The examiner can normally be reached on M - F, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

TP

Tim Phan  
Examiner  
Art Unit 3729

tp  
September 17, 2002

of

CARL J. ARBES  
PRIMARY EXAMINER